

Remarks

Claims 1-12 are pending.

Claim 1 has been amended to explicitly state that the reaction is conducted without the addition of hydrofluoric acid. Support for the amendment to claim 1 is found throughout the teachings of the original specification. Applicants request entry of the amendment.

Based on the foregoing amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Clarification of the Specification

The present specification discloses that Kempf specifically teaches chlorination in a hydrofluoric acid medium. Kempf does not teach the use of another solvent in the absence of hydrofluoric acid. This is the context in which the present specification states with regard to the Kempf reference, "use of an other [sic] solvent is not mentioned."

II. Claim Rejections Under 35 U.S.C. § 102(b)

The Office Action alleges that claims 1-12 are anticipated by the process of Kempf et al. (USPN 6,747,175) ("Kempf"). Claim 1 has been amended to explicitly state that the reaction proceeds without the addition of hydrofluoric acid. On the other hand, the process of Kempf *must* proceed in a hydrofluoric acid medium. Therefore, Kempf does not teach each and every limitation of claim 1 or any of its dependent claims 2-12. Therefore, Kempf cannot anticipate any of claims 1-12. Applicants respectfully request withdrawal of the rejections.

III. Claim Rejections Under 35 U.S.C. § 103

a. Newly Presented Rejections

The Office Action presents new rationale at page 5 and alleges that claims 1-12 are obvious over Kempf. Applicants respectfully traverse. According to the Office Action:

One of ordinary skill in the art would have been motivated to use a polar aprotic solvent because, as suggested by the teaching of Kempf et al., it is known in the art that the *mixture* of polar protic solvents and polar aprotic solvents are useful in a dichlorination reaction to produce 2,6-dichloro-para-trifluoromethylaniline.

Under Response to Arguments, Item 7, p. 5. (Emphasis added.) First, Kempf is directed to a reaction that invariably proceeds in a hydrofluoric acid medium. The present claims, on the other hand, do not include adding hydrofluoric acid to the reaction at any point. Second, the data in Kempf show that when a monochlorobenzene/hydrofluoric acid mixture is used, the reaction yield is the lowest. See, col. 5, Table, Test No. 3. The Office Action provides *no reason beyond a general statement* that a mixture of solvents is suggested by Kempf and that such a mixture would be useful. However, the data show that such a mixture is not very useful at all given the disclosed alternatives. Nevertheless, the presently claimed process *does not include* the hydrofluoric acid required in Kempf nor the mixture disclosed therein. For at least these reasons, the Office Action has not established a *prima facie* case of obviousness against claims 1-12. Applicants respectfully request withdrawal of the rejections.

b. Maintained Rejections

The Office Action states that claims 1-12 “are unpatentable over Kempf for reasons given in the previous office actions mailed July 19, 2007 and January 15, 2008.” OA, Item 11, p. 6. Applicants respectfully submit that *this rejection is improper* because the substance of Applicant’s Replies to either of the above-cited Office Actions has not been answered as required by M.P.E.P. § 707.07(f).

In the case of the *reasons given* in the July 19, 2007, Office Action, Applicants submitted a Reply on November 15, 2007.¹ In response, the next Office Action stated:

Applicant’s arguments, see Amendment, filed November 15, 2007, with respect to the rejection(s) of claim(s) 1-12 under 35 USC § 103 *have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.*

OA of January 15, 2008, p. 2. (Emphasis added.) By withdrawing the rejection in this manner and apparently re-instating it now, the Office Action *has not answered the substance* of the Reply of November 15, 2007.

¹ The substance of the Reply included arguments against: (1) the veracity and relevance of a Wikipedia reference teaching of the “ion dissolving power” of polar aprotic solvents and protic solvents; (2) the veracity, relevance and properness of the official notice “that protic solvents and aprotic solvents of high polarity react similarly in substitution reactions;” and (3) the veracity, relevance and properness of the official notice regarding “art recognized alternative solvents.”

Regarding the reasons given in the January 15, 2008, Office Action, Applicants submitted a Reply on April 15, 2008. Applicants presented arguments against the Office Action's interpretation of the phrase "para-trifluoromethylaniline freed from its hydrofluoric acid." Further, Applicants argued against the Office Action's reasoning that one of ordinary skill in the art would conduct the reaction "using *just* paratrilfluoromethylaniline and chlorine in the monochlorobenzene (polar aprotic solvent) in a *desire to increase yield....*" (Emphasis added.) Replying to Applicant's arguments in name only, the current Office Action at page 4, under Response to Arguments, states that the "features upon which applicant relies (i.e., higher yield) are not recited in the rejected claim(s)." Here, the current Office Action conflates the issue and does not reach the substance of it. Applicants argued against the Office Action's reasoning regarding the feature allegedly suggested in *Kempf* where one of ordinary skill in the art having read and understood *Kempf* would use monochlorobenzene to *increase yield* against the weight of the data shown in col. 5, Table, Test No. 3. Continuing under Response to Arguments at p. 5, first paragraph, the Office Action refers to the alleged motivation to use a *mixture* of polar protic and polar aprotic solvents. However, this is a *new ground of rejection* because the crux of previous rejections is not concerned with a solvent mixture at all.² Lastly, on p. 5, second paragraph, it is alleged that there is motivation to choose "art recognized alternative solvents." This term has been argued against previously, and is referred to herein in footnotes 1 and 2. In sum, the Office Action under Response to Arguments, conflates an issue, adds a new ground of rejection and without supporting evidence resurrects official notice of "art recognized alternative solvents," but *does not answer the substance* of the Reply of April 15, 2008.

Applicants have a right to be heard and submit that each of the rejections has already been argued and overcome. Applicants respectfully request withdrawal of the rejections. If

² For example, the Office Action of January 15, 2008, is not concerned with a mixture. Rather, it states:

Applicant's claimed steps merely omit the use of an acid medium in its process for the dichlorination of the para-trifluoromethylaniline. The rationale to omit this step is implied by *Kempf et al.* when it is disclosed that in the process of *Kempf et al.* chlorination of the para-trifluoromethylaniline is carried out once the para-trifluoromethylaniline was freed from the hydrofluoric acid.

OA, pp. 3-4. Likewise, the Office Action of July 19, 2007 is not concerned with a mixture. Rather, it focuses on substituting a protic solvent for an aprotic one because both allegedly "react similarly in substitution reactions." OA, p. 7. The Office Action states, "[o]ne of ordinary skill in the art would be motivated to choose art recognized alternative solvents...." *Id.*, pp. 7-8.

the rejections are maintained, Applicants request that the substance of the Replies be answered as required by the M.P.E.P. to more clearly develop the issues.


Conclusion

Reexamination of the application and reconsideration of the rejection is respectfully requested. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

Respectfully submitted,

BRINKS HOFER GILSON & LIONE

Date: JANUARY 21, 2009

By: 
Bryan L. Skelton
Registration No. 50,893

2801 Slater Road
Suite 120
Morrisville, NC 27560